

PATENT

Serial No. 09/609,286

Atty. Dkt. No. SEDN/5219

**REMARKS**

This response is intended as a full and complete response to the final Office Action mailed January 13, 2005. In the Office Action, the Examiner notes that claims 1-27 are pending and rejected. By this response, Applicants' have amended claims 1, 9, 18 and 22. The amendments to the claims are fully supported by the Specification, for example at least at page 20, line 26, through page 21, line 4; page 25, lines 13-22, page 30, line 19, through page 31, line 13; and page 66, lines 14-21.

In view of both the amendments presented above and the following discussion, the Applicants submit that none of the claims now pending in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and 103.

It is to be understood that the Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to the Applicants' subject matter recited in the pending claims. Further, the Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

**Amendments to the Specification**

The Specification has been amended to clarify that the present application is, inter alia, a continuation-in-part of U.S. Application Serial Number 09/597,893, which is a continuation-in-part of U.S. Application Serial Number 09/054,419, now U.S. Patent No. 6,463,585, which is a continuation-in-part of U.S. Application Serial Number 08/735,549, now U.S. Patent No. 6,738,978.

**Rejections****35 U.S.C. §103****Claims 22 and 25**

The Examiner has rejected claims 22 and 25 under 35 U.S.C. §103(a) as being unpatentable over Lanier et al. (U.S. 5,588,104, hereinafter "Lanier '104")

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in view of Blahut et al. (U.S. 5,446,490, hereinafter "Blahut"). The Applicants respectfully traverse the rejection.

The Applicants' independent claim 22 recites:

"22. A method for placing virtual objects into video programs at a viewer's terminal, comprising:  
receiving a plurality of virtual objects comprising first virtual objects intended for the viewer's terminal and second virtual objects intended for other terminals;  
receiving a video program including one or more virtual object locations, the video program including virtual object information for placement of virtual objects into the video program;  
receiving a group assignment matrix and a retrieval plan for the viewer's terminal and the other terminals;  
executing the retrieval plan at the viewer's terminal to instruct, based on the group assignment matrix, the viewers terminal to select one or more of the plurality of virtual objects, wherein the executing step includes comparing the virtual object information and the received virtual objects to select virtual objects for placement in the virtual object locations; and  
inserting the selected virtual objects into the virtual object locations."

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Lanier '104 and Blahut references alone or in combination fail to teach or suggest the Applicants' invention as a whole.

Specifically, the Lanier '104 and Blahut references, alone or in combination, fail to teach or suggest at least the "receiving a plurality of virtual objects comprising first virtual objects intended for the viewer's terminal and second virtual objects intended for other terminals," the "receiving a group assignment matrix and a retrieval plan for the viewer's terminal and the other terminals," and the "executing the retrieval plan at the viewer's terminal to

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instruct, based on the group assignment matrix, the viewers terminal to select one or more of the plurality of virtual objects" as recited in claim 22 as amended.

Lanier '104 discloses a method and apparatus for creating virtual worlds using a data flow network. The method uses a computer terminal to display the data flow network as a plurality of interconnected units. An interactive program allows the appearance of the plurality of interconnected units to be changed. The data flow network is then automatically altered to correspond with the visual changes. However, Lanier '104 does not teach or suggest receiving virtual objects intended for both the particular computer terminal being used and other computer terminals as well. Lanier '104 also does not teach or suggest receiving a group assignment matrix and a retrieval plan at the computer terminal. Furthermore, Lanier '104 does not teach or suggest executing the retrieval plan at the computer terminal to instruct, based on the group assignment matrix, the computer terminal to select one or more of the virtual objects.

The Blahut reference fails to bridge the substantial gap between the Lanier '104 reference and the Applicants' invention as recited in amended claim 22. Blahut discloses that "Different components of television programs, such as the video and audio components or different time segments of the program, are assigned to different channels transmitted in the form of packetized digital information in at least one of the channels of a multi-channel cable television system" (abstract). Blahut also discloses that "a particular subscriber's converter is configured to receive a particular subset of program components by enabling the converter to receive the virtual channels carry the components in such subset" (abstract). However, Blahut also does not teach or suggest receiving a group assignment matrix and a retrieval plan at the subscriber's converter. Furthermore, Blahut does not teach or suggest executing the retrieval plan at the subscriber's converter to instruct, based on the group assignment matrix, the subscriber's converter to select one or more of the virtual objects.

Therefore, the Lanier '104 and Blahut references, alone or in combination, fail to teach the applicants invention, as recited in claim 22, as a whole.

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As such, the Applicants submit that independent claim 22 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claim 25 depends directly from independent claim 22 and recites additional features thereof. As such and at least for the same reasons as discussed above, the Applicants submit that dependent claim 25 is also not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

**Claims 1-6, 8-14, 16-21, 23, 24, 26 and 27**

The Examiner has rejected claims 1-6, 8-14, 16-21, 23, 24, 26 and 27 under 35 U.S.C. §103(a) as being unpatentable over Lanier '104 in view of Lanier et al. (U.S. Patent 5,588,139, hereinafter "Lanier '139") further in view of Blahu. The Applicants respectfully traverse the rejection.

The Applicants' independent claim 1 recites:

"1. A method for placing virtual objects in virtual object locations in a video program at a viewer's terminal, comprising:  
receiving a plurality of virtual objects for use with one or more of the virtual object locations in the video program, wherein the plurality of virtual objects comprises first virtual objects intended for the viewer's terminal and second virtual objects intended for other terminals;  
storing the plurality of virtual objects in the viewer's terminals;  
receiving a group assignment matrix and a retrieval plan for the viewer's terminal and the other terminals;  
executing the retrieval plan at the viewer's terminal to instruct, based on the group assignment matrix, the viewer's terminal to select one or more of the plurality of virtual objects; and  
inserting the selected one or more of the received plurality of virtual objects into one or more of the virtual object locations during a display or storage of the video program at the viewer's terminal."

As discussed above, the Lanier '104 and Blahut references, alone or in combination, do not teach or suggest the Applicants' invention as a whole, as recited in independent claim 22. Moreover, independent claim 1 includes substantially similar relevant limitations as those discussed above in regards to claim 22. Therefore, the Lanier '104 and Blahut references, alone or in

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combination, do not teach or suggest the Applicants' invention as a whole, as recited in independent claim 1.

Furthermore, the Lanier '139 reference fails to bridge the substantial gap between the Lanier '104 and Blahu references and the Applicants' invention as recited in claim 1. Lanier '139 discloses "[a] computer model of a virtual environment is continuously modified by input from various participants. The virtual environment is displayed to the participants using sensory displays such as head-mounted visual and auditory displays which travel with the wearer and track the position and orientation of the wearer's head in space." (abstract) However, Lanier '139 also does not teach or suggest receiving a group assignment matrix and a retrieval plan at the viewer's terminal. Furthermore, Lanier '139 does not teach or suggest executing the retrieval plan at the viewer's terminal to instruct, based on the group assignment matrix, the subscriber's converter to select one or more of the virtual objects.

Therefore, the Lanier '104, Blahut and Lanier '139 references, alone or in combination, fail to teach the applicants invention, as recited in claim 1, as a whole.

As such, the Applicants submit that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 9, 18 and 22 include substantially similar relevant limitations as those discussed above in regards to claim 1. Therefore, independent claims 9, 18 and 22 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 2-6, 8, 10-14, 16-17, 19-21, 23, 24, 26 and 27 depend, either directly or indirectly, from independent claims 1, 9, 18 and 22 and recite additional features thereof. As such and at least for the same reasons as discussed above, the Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

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**Claims 7 and 16**

The Examiner has rejected claims 7 and 16 under 35 U.S.C. §103(a) as being unpatentable over Lanier '104 in view of Lanier '139 further in view of Blahu further in view of de Hond (U.S. Patent 5,737,533, hereinafter "Hond"). The Applicants respectfully traverse the rejection.

As discussed above, the Lanier '104, Blahut and Lanier '139 references, alone or in combination, do not teach or suggest the Applicants' invention as a whole as recited in independent claim 1.

Furthermore, the Hond reference fails to bridge the substantial gap between the Lanier '104, Lanier '139 and Blahut references and the Applicants' invention. Hond discloses "[a] system comprising a server having a memory, and a database defined in the memory; and a client in communication with the server, the server communicating to the client an interface for use in requesting a search of the database, and the server having virtual reality means for generating a virtual reality scene, the virtual reality scene varying depending on the results of the search." (abstract) However, Hond also does not teach or suggest receiving a group assignment matrix and a retrieval plan at the viewer's terminal. Furthermore, Hond does not teach or suggest executing the retrieval plan at the viewer's terminal to instruct, based on the group assignment matrix, the subscriber's converter to select one or more of the virtual objects.

Therefore, the Lanier '104, Blahut, Lanier '139 and Hond references, alone or in combination, fail to teach the applicants invention, as recited in claim 1, as a whole.

As such, the Applicants submit that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claim 9 includes substantially similar relevant limitations as those discussed above in regards to claim 1. Therefore, independent claim 9 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claims 7 and 16 depend, either directly or indirectly, from independent claims 1 and 9 and recite additional features thereof. As such and at least for the same reasons as

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discussed above, the Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

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**CONCLUSION**

Thus, the Applicants submit that none of the claims presently in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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